

## **REMARKS**

In response to the above-identified Office Action, Applicant seeks reconsideration of the application. In this response, no claims are canceled, no claims are amended and no claims are added. Accordingly, Claims 1, 4-10, 13-29 are pending.

### **I. Claims Rejected Under 35 U.S.C. §102(e)**

Claims 1, 4, 5, 8-10, 13, 14 and 17-19 are rejected under 35 U.S.C. §102(e) as being anticipated by Jouppi et al. (U.S. Patent No. 6,112,318). Applicant respectfully traverses this rejection.

Applicant respectfully submits that Claim 1 is not anticipated by Jouppi. Particularly, Applicant submits that Jouppi does not teach or suggest allowing a user to select a subset of event from a performance object containing a plurality of events such that counters associated with events that are not selected from the performance object are not incremented, as recited in Claim 1.

With respect to Claim 1, the Examiner admits that Jouppi does not explicitly disclose “such that counters associated with events that are not selected from said at least one performance object are not incremented during the collection session” as recited in Claim 1. However, the Examiner asserts that this limitation is considered inherent “because ‘counters associated with events that are selected from said at least one performance object are incremented during the collection session’ disclosed by Jouppi et al is logically meant by ‘counter associated with events that are not selected from said at least one performance object are not incremented during the collection session’ since the action of ‘incrementing’ could never be activated if the action of ‘selecting’ is not activated.”

To establish anticipation by inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 U.S.P.Q. 2d 1746, 1749 (Fed. Cir. 1991). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. At 1269.

In finding anticipation by inherency, the Examiner has indicated that “counters associated with events that are selected from said at least one performance object are incremented during

the collection session” disclosed by Jouppi implies that “counter associated with events that are not selected from said at least one performance object are not incremented during the collection session.” In doing so, the Examiner asserts that the action of ‘incrementing’ could never be activated if the action of ‘selecting’ is not activated.” Applicant respectfully disagrees. As noted in the present patent application, in a preexisting performance monitoring tool, such as the Windows Perfmon program, a counter contained within a performance object may be incremented during a collection session even if the counter has not been selected from the performance object. Since preexisting performance monitoring tool, such as the Windows Perfmon program, enables counters to increment without being selected by a user, there is no compelling reason why the counters of Jouppi must not be capable of incrementing without being selected by a user. Applicant notes that inherency requires that the alleged inherent feature must be present, not only that it might be present. However, the Examiner’s inherency analysis rests only upon unsupported conjecture that the counters of Jouppi are not capable of incrementing without being selected by a user. It is therefore respectfully submitted that the limitation recited in Claim 1 that “counters associated with events that are not selected from said at least one performance object are not incremented during the collection session” is not disclosed by Jouppi, either explicitly or inherently.

Additionally, Applicant respectfully submits that Jouppi does not teach or disclose a performance counter associated with a selectable event that is implemented using a software variable, as recited in Claim 1. In rejecting Claim 1, the Examiner asserts that this limitation “at least another one of the performance counters associated with the selectable events is implemented using a software variable” is taught by Jouppi, citing column 5, lines 56 to column 6, line 65 and column 16, line 52 to column 17, line 31. However, these passages in Jouppi referred by the Examiner in no way teach or suggest a performance counter implemented using a software variable. Jouppi discloses a performance monitoring system that employs performance counters that are embodied in the form of hardware registers. Consequently, there is nothing in Jouppi that teaches or suggests implementing at least one of the performance counters associated with selectable events using a software variable, as recited by Applicant.

In accordance with one embodiment, the system is described for monitoring performance counters that exist in software codes (e.g., performance counters implemented using software variables) as well as performance counters that are implemented using hardware registers. By

enabling a user to select and monitor performance counters in the form of hardware registers and software variables, this allows the user to observe relationships and interactions between the software code and various hardware components within a given computer system. Such information may be used by software developers to optimize their software application to run more effectively on the computer system. Claim 1 requires that at least one of the performance counters associated with selectable events is implemented using a hardware register and at least another one of the performance counters associated with selectable events is implemented using a software variable.

In contrast, Jouppi discloses a performance monitoring system that employs performance counters that are embodied in the form of hardware registers. Therefore, Jouppi fails to disclose or suggest implementing at least one of the performance counters associated with selectable events using a software variable, as recited by Applicant.

Analogous arguments to those above apply to independent Claims 10 and 19.

As to Claim 10, Applicant respectfully submits that Jouppi does not disclose, either explicitly or inherently, configuring a collection session by allowing a user to selectively choose a subset of events to be monitored during a collection session from a performance object containing a list of events such that counters associated with events that are not selected from the performance object are not incremented during the collection session, as recited by Applicant. Moreover, Applicant submits that Jouppi fails to disclose at least one performance counter associated with a selectable event that is implemented using a software variable, as required by Claim 10.

With respect to Claim 19, Applicant respectfully submits that Jouppi does not disclose, either explicitly or inherently, enabling a user to selectively choose a subset of events to be monitored during a collection session from a performance object containing a list of events such that counters associated with events that are not selected from the performance object are not incremented during the collection session, as recited by Applicant. Furthermore, Applicant submits that Jouppi fails to disclose at least one performance counter that is implemented using a software variable, as required by Claim 19.

In view of the foregoing, Applicant respectfully submits that independent Claims 1, 10 and 19 are not anticipated by Jouppi and requests withdrawal of the rejection of these claims. Regarding dependent Claims 4, 5, 8, 9, 13, 14, 17, 18, Applicant submits that these claims are

not anticipated by Jouppi at least for the same reasons given in connection with their base Claims 1 and 10.

## **II. Claims Rejected Under 35 U.S.C. 103(a)**

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jouppi in view of Anderson ("Your Right to Know; Finding Leaks and Bottlenecks with a Windows NT Perfmon COM Object", Microsoft Corporation, January 1999). Claims 15, 16 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jouppi in view of Ranganathan (U.S. Patent No. 6,098,169). Claims 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jouppi in view of Ranganathan and further in view of Anderson. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jouppi in view of Anderson and Agrawal et al. (U.S. Patent No. 5,881,223). Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jouppi in view Agrawal. Applicant respectfully traverses these rejections.

With respect to Claims 6 and 7, Applicant submits that these claims are dependent on independent Claim 1 and therefore, the discussion above with regard to the independent Claim 1 and Jouppi applies here. Because Jouppi does not contain limitations recited in Applicant's independent Claim 1 as set forth above, and because Anderson does not cure these deficiencies, the combination of Jouppi and Anderson does not teach or suggest Applicant's dependent Claims 6 and 7. It is therefore respectfully submitted that Claims 6 and 7 are patentable over Jouppi in view of Anderson.

As to Claims 15, 16 and 20-24, Applicant submits that these claims are dependent on independent Claims 10 and 19 and therefore, the discussion above with regard to the independent Claims 10 and 19 and Jouppi applies here. Because Jouppi does not contain limitations recited in Applicant's independent Claims 10 and 19 as set forth above, and because Ranganathan does not cure these deficiencies, the combination of Jouppi and Ranganathan does not teach or suggest Applicant's dependent Claims 15, 16 and 20-24. It is therefore respectfully submitted that Claims 15, 16 and 20-24 are patentable over Jouppi in view of Ranganathan.

With respect to Claim 25, Applicant submits that this claim is dependent on independent Claim 19 and therefore, the discussion above with regard to the independent Claim 19 and Jouppi applies here. Because Jouppi does not contain limitations recited in Applicant's independent Claim 19 as set forth above, and because neither Ranganathan nor Anderson cures

these deficiencies, the combination of Jouppi, Ranganathan and Anderson does not teach or suggest Applicant's dependent Claim 25. It is therefore respectfully submitted that Claim 25 is patentable over Jouppi in view of Ranganathan and further in view of Anderson.

As to Claims 26 and 27, Applicant submits that these claims are dependent on independent Claim 1 and therefore, the discussion above with regard to the independent Claim 1 and Jouppi applies here. Because Jouppi does not contain limitations recited in Applicant's independent Claim 1 as set forth above, and because neither Anderson nor Agrawal cures these deficiencies, the combination of Jouppi, Anderson and Agrawal does not teach or suggest Applicant's dependent Claims 26 and 27. It is therefore respectfully submitted that Claims 26 and 27 are patentable over Jouppi in view of Anderson and Agrawal.

With respect to Claims 28 and 29, Applicant submits that these claims are dependent on independent Claim 19 and therefore, the discussion above with regard to the independent Claim 19 and Jouppi applies here. Because Jouppi does not contain limitations recited in Applicant's independent Claim 19 as set forth above, and because Agrawal does not cure these deficiencies, the combination of Jouppi and Agrawal does not teach or suggest Applicant's dependent Claims 28 and 29. It is therefore respectfully submitted that Claims 28 and 29 are patentable over Jouppi in view of Agrawal.

### CONCLUSION

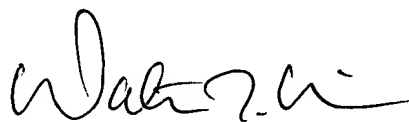
In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance, and such action is earnestly solicited at the earliest possible date. If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees. If a telephone interview would expedite the prosecution of this Application, the Examiner is invited to contact the undersigned at (310) 207-3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Dated: December 2, 2003

By:

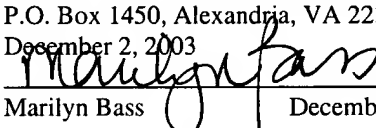
  
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December 2, 2003